

REMARKS

Applicant has reviewed the Office Action of March 15, 2004, and offers the following Remarks. Reconsideration of the instant case is respectfully requested.

I. Claim Objections

Claims 18, 19, 21-34, 50 and 51 were objected to because of the informalities detailed on page 2 of the Office Action.

Claims 18 and 19 have been amended to recite "system" instead of "method."

Claim 20 has been amended to recite a system claim, and thus dependent claims 21-34 are now consistent with claim 20.

Claims 50 and 51 have been amended to depend from claims 46 and 50, respectively. Applicant has also amended claim 46 to recite that the program is stored in a computer-readable medium.

Applicant submits that the amendments are fully responsive to the objections and requests that the rejections be withdrawn.

II. Claim Rejections Under 35 U.S.C. § 103(a)

Independent claims 1, 11, 20, 35, and 46 were rejected under 35 U.S.C. § 103(a) as being obvious over Sherman (U.S. Pat. No. 5,505,214) in view of Waskiewicz (U.S. Pat. No. 5,822,526). The Applicant respectfully disagrees with the rejection of claims 1, 11, 20, 35 and 46 and the claims depending therefrom. Support for the Applicant's argument is set forth below.

A. Waskiewicz

Waskiewicz teaches an e-mail address proxy system in which a plurality of proxy e-mail addresses may be associated with a user account name. A user may add or modify a proxy address for the user without changing the user's account name to facilitate easy non-disruptive modifications to a user's email address. A user's email mailbox address may have associated with it multiple proxy addresses. By disassociating the user's email address from an account name, the system of Waskiewicz allows a user to have an email

address that renders the user's identity completely anonymous. Waskiewicz, col. 2, ll.6-20.

Fig. 3 of Waskiewicz shows directory 40 relating to associating proxy addresses with email addresses. A "User Name" portion 60 of the directory 40 lists user account names corresponding to email accounts. The User Name portion 60 is similar to the user account name used in known systems to obtain an associated system level logical mailbox address for an account. System level logical mailbox addresses are provided in a Mailbox Logical Address portion 62 of the directory 40 (column 2 in Fig. 3). Rather than provide direct addresses for mailboxes, the system level logical mailbox addresses comprise handles referencing the actual logical addresses (in brackets). Handles are well-known system level-references to objects that are issued for temporary reference to a particular resource and then discarded by the user of the handle. The use of handles enables the DSA 46 to withhold the actual address from requesting processes that may attempt to corrupt the system. The directory may be implemented as an array comprising a user account name entry and the other information illustratively depicted in Fig. 3. Waskiewicz, col. 5, ln. 65 - col. 6, ln. 18.

A proxy list portion 64 of the directory 40 comprises a new field in the directory which enables a user to designate user names for determining a mailbox address that are distinct from the (difficult-to-modify) user account name. Each entry in the Proxy list portion 64 is capable of storing multiple proxy addresses for a given user account. Waskiewicz, col. 6, ll. 19-34.

B. Sherman

Sherman is directed toward a system for synchronizing data between multiple computing systems. Sherman, col. 2, ll. 19-21. Sherman defines synchronization as involving "an electronic comparison and correlation of data between the companion device and the primary computer (such as a server or personal computer) to maintain data uniformity on both systems." Sherman, col. 1, ll. 36 - 39. In particular, a primary file hierarchy and data stored in the primary file hierarchy in a primary system is selectively synchronized with a companion file hierarchy and data stored in the companion file

hierarchy in a companion system. The data and/or file hierarchy to be synchronized is determined by a user indication of interest. Sherman, col. 7, ll. 50-54.

Fig. 6 provides an operation flow diagram for synchronizing a subset of folders in an e-mail folder hierarchy in Sherman. Connection operation 250 establishes the connection between the H/PC and the server or other primary computer. An "expanded flag" is set in the H/PC folder database for each folder whose subfolder list is to be synchronized, and it is this "expanded flag" that is monitored by monitor operation 252 in Fig. 6. The presence of an asserted expanded flag on a top-level folder is detected by monitor operation 252. Sherman, col. 9, ll. 29-42.

If the expanded flag is not set, operation 254 determines whether there are more top-level folders. Where there is only one top-level folder, and the expanded flag is set by default. Where it is found that the expanded flag associated with the top-level folder is set, synchronization of the subfolders of the top-level folder is initiated at synchronization operation 256. This results in providing the H/PC user a folder hierarchy on the H/PC that includes the top-level folder and the immediate subfolders of that folder. For example, referring briefly to Fig. 5, the Level₁ Service Hierarchy Folder 200 corresponds to the top-level folder, and Folders 202, 204 and 206 correspond to the immediate subfolders that will be synchronized. If the only expanded flag set was for the Service Hierarchy Folder 200, the H/PC would synchronize Folders 202, 204 and 206, but would not synchronize folders at subsequent levels (i.e., Level₂, Level₃, etc.). Sherman, col. 9, ll. 44-61.

C. Independent Claim 1

The Applicant respectfully submits that independent claim 1 is not obvious over Sherman and Waskiewicz because 1) Sherman teaches away from claim 1; 2) Sherman and Waskiewicz, when combined, do not teach a "recipient data set" as claimed in claim 1; 3) not all of the limitations of each element was addressed in the rejection; and 4) Sherman and Waskiewicz cannot be shown to teach all of the claimed limitations.

First, Sherman teaches away from claim 1. Sherman teaches the synchronization of data between a first computer system and a second computer system, while claim 1 claims "creating a plurality of recipient data sets by associating each data set associated

with a class to each recipient account associated with the class so that each recipient data set includes only data sets associated with each corresponding recipient account. A recipient data set is specifically defined in the specification at pg. 2, ll. 13-14; pg. 8, ll. 15-17; pg. 19, ll. 12-13.¹ Claim 1 should be examined with the meaning provided by Applicant. See In re Zletz, 893 F.2d 319, 321 (Fed. Cir. 1989) ("When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art").

The Applicant respectfully submits that Sherman, either alone or in combination with Waskiewicz, teaches away from claim 1. Recall that Sherman defines synchronization as involving "an electronic comparison and correlation of data between the companion device and the primary computer (such as a server or personal computer) to maintain data uniformity on both systems." The recipient data set as claimed in claim 1, however, includes only data associated with each corresponding recipient account. Clearly, data sets that only include data associated with each corresponding recipient account are not uniform data sets. Thus, Sherman teaches a system that creates data uniformity between a first computer system and a second computer system, and claim 1 claims a method for creating unique recipient data sets for each recipient and that are to be distributed to the recipients.

It is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743 (Fed. Cir. 1983). Therefore, because Sherman teaches away from claim 1, the Applicant respectfully submits that the rejection is improper and requests that the rejection of claim 1, and all claims depending therefrom, be withdrawn.

Second, Sherman, either alone or in combination with Waskiewicz, does not teach a recipient data set as defined by the specification. As described above, Sherman is directed to synchronization to maintain data uniformity between two computer systems, and Waskiewicz is directed toward proxy accounts for users. Claim 1 is directed to creating and distributing to recipient accounts recipient data sets that include only data

¹ Recipient data sets are also described in provisional application Ser. No. 60/223,766, filed August 8, 2001, at page 4, line 26 - page 5, line 27.

sets associated with each corresponding recipient account. Nowhere in Sherman or Waskiewicz is there a teaching or suggestion of creating recipient data sets as defined in the specification and claims, i.e., a data set that includes only data associated with each corresponding recipient account. Because the combination of Sherman and Waskiewicz do not teach all of the claimed limitations, the Applicant requests that the rejection of claim 1, and all claims depending therefrom, be withdrawn.

Third, the limitations "associated with each recipient account" to the "recipient data set" element was not addressed in the rejection. The rejection on page 3 of the Office Action only refers to "creating a plurality of recipient data sets by associating each data set associated with a class to each recipient account associated with the class so that each recipient data set includes only data." The Office Action acknowledges that Sherman does not teach a plurality of recipient accounts, and thus cannot teach the association with the plurality of recipient accounts. Waskiewicz is then cited as disclosing a recipients' address directory and user names as classes in an e-mail folder hierarchy on page 4 of the Office Action, and thus could be used to obtain recipient mailing addresses. Waskiewicz, then, is only cited for the fact that multiple users may have accounts. However, it is not explained how this combination teaches or may be modified to teach the following emphasized limitations in each claim element:

associating a plurality of classes arranged in a class hierarchy with the plurality of recipient accounts;

associating a plurality of data sets with the plurality of classes and the plurality of recipient accounts;

creating a plurality of recipient data sets by associating each data set associated with a class to each recipient account associated with the class so that each recipient data set includes only data sets associated with each corresponding recipient account.

Because the obviousness rejection does not specifically state how the combination of Sherman and Waskiewicz teaches these claimed limitations, the rejection fails to show how the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP § 2143. Thus, the rejection of claim 1, and all claims depending therefrom, is improper and must be withdrawn.

Finally, the Applicant respectfully submits that the combination of Sherman and Waskiewicz cannot be shown to teach the above-emphasized claim limitations. In particular, the passages to Waskiewicz cited in the Office Action only refer to proxy addresses for e-mail recipients, and that there are multiple user accounts on an e-mail server. The folder hierarchy of Sherman is merely an e-mail folder hierarchy for a single user. Neither Sherman nor Waskiewicz relate to multiple recipient accounts and the hierarchical association of data to the multiple recipient accounts. Thus, Sherman and Waskiewicz, either alone or in combination, only teach e-mail hierarchies for multiple users. Sherman and Waskiewicz, however, either alone or in combination, do not teach the above-emphasized associations with a plurality of recipient accounts and the corresponding generation of recipient data sets. For this additional reason, the Applicant respectfully submits that the rejection of claim 1, and all claims depending therefrom, be withdrawn.

D. Dependent Claims 3, 4 and 10

Claims 3, 4 and 10 were rejected on the grounds that Sherman disclosed an e-mail folder hierarchy for a single recipient account and that Waskiewicz disclosed an address directory for multiple recipients. Office Action, pp. 4-5.

In addition to being allowable due to their dependence either directly or indirectly from claim 1, the Applicant also submits that these claims are allowable because Sherman and Waskiewicz do not disclose the added limitations. With respect to claim 3, the Office Action does not explain how Sherman and Waskiewicz disclose, teach or suggest "associating a data set with a parent class; and associating the data set associated with the parent class with a related child class." With respect to claim 4, the Office Action does not explain how Sherman and Waskiewicz disclose, teach or suggest "associating each data set associated with a child class to each recipient account associated with the child class." Finally, with respect to claim 10, the Office Action does not explain how Sherman and Waskiewicz disclose, teach or suggest "disassociating the plurality of data sets with the plurality of classes and the plurality of recipient accounts." For these additional reasons, the Applicant requests that the rejection of these claims be withdrawn.

E. Independent Claim 11

Independent claim 11 was rejected for the same reasons that claim 1 was rejected. Because claim 11 recites similar limitations to claim 1, the Applicant incorporates the arguments presented with respect to claim 1 for claim 11. For the same reasons given with respect to claim 1, the Applicant respectfully submits that the rejection of claim 11, and all claims depending therefrom, be withdrawn.

F. Dependent Claims 12-15 and 19

Claims 12-14 and 19 were rejected for the same reasons that claims 2-4 and 10 were rejected. Office Action, pp. 4-6. For the same reasons given in with respect to claims 2-4 and 10, the Applicant requests that the rejection of these claims be withdrawn.

G. Independent Claim 20

Independent claim 20 recites a data structure including a plurality of classes arranged in a class hierarchy, and a plurality of recipient accounts associated with the plurality of classes, and a program wherein the program associates data sets to selected classes and selected recipient accounts, and creates a plurality of recipient data sets by associating data sets associated with a selected class to the recipient accounts associated with the selected class so that each recipient data set includes only data sets associated with each corresponding recipient account.

The Office Action rejection of claim 20 over Sherman and Waskiewicz is substantially similar to the rejection of claim 1, and the Applicant incorporates the arguments presented with respect to claim 1 for claim 20. For the same reasons as given with respect to claim 1, the Applicant respectfully submits that the rejection of claim 20 is improper because 1) Sherman teaches away from claim 20 as Sherman teaches maintaining data uniformity and not the creation of recipient data sets; 2) Sherman, either alone or in combination with Waskiewicz, does not teach a recipient data set as defined by the specification; 3) the limitations "associates data sets to selected classes and selected recipient accounts" to the "recipient data set" element was not addressed in the rejection; and 4) regardless of (3) above, Sherman and Waskiewicz, when combined, cannot be shown to teach the above-emphasized claim limitations. Thus, for the same

reasons give with respect to claim 1, the Applicant respectfully submits that the rejection of claim 20, and all claims depending therefrom, be withdrawn.

H. Dependent claim 22 - 25

Claims 21 - 23 were rejected on the grounds that Sherman disclosed an e-mail folder hierarchy for a single recipient account and that Waskiewicz disclosed an address directory for multiple recipients. Office Action, pp. 8-9.

In addition to being allowable due to their dependence either directly or indirectly from claim 20, the Applicant also submits that these claims and claims depending therefrom are allowable because Sherman and Waskiewicz do not disclose the added limitations. With respect to claim 22 in particular, Sherman and Waskiewicz have not been shown to teach the claimed distribution control file. In fact, the Office Action does not even mention this limitation in this rejection or in the later rejection over Sherman and Waskiewicz in combination with U.S. Pat. No. 6,345,288, issued to Reed et al. ("Reed."). Thus, the rejection fails to show how the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP § 2143. For this additional reason alone, the rejection of claim 22, and the rejection of claims 23, 24, and 25, which depend from claim 22, must be withdrawn, as Sherman and Waskiewicz have not been shown to teach the distribution control file limitation.

I. Dependent claims 26 - 31

The Office Action states that the graphics file disclosed in Sherman is a transaction file that stores a transaction history of the distribution of data sets. The Applicant respectfully disagrees with this rejection. The specification describes a transaction file on page 16, lines 5-12. A graphics file, however, is merely a file that includes graphics information. A graphics file does not "store a transaction history of the distribution of data sets." Clearly, the claimed transaction file is not met by a graphics file of Sherman as applied.

Furthermore, the Office Action is conclusory in the rejection. The Office Action does not show how a graphics file could be modified to teach this limitation, nor does the Office Action show how the art provides a suggestion or motivation for such

modification. Thus, the Office Action does not show how the prior art reference (or references when combined) teach or suggest this claim limitation. MPEP § 2143. For these reason alone, the rejection of claim 26, and claims 27-31, which depend from claim 26, must be withdrawn, as Sherman and Waskiewicz have not been shown to teach this limitation.

J. Dependent claims 32 - 34

Claims 32 - 34 were rejected on the grounds that Sherman disclosed an e-mail folder hierarchy for a single recipient account and that Waskiewicz disclosed an address directory for multiple recipients. Office Action, pp. 9-10. The Applicant respectfully disagrees with the rejection.

In addition to being allowable due to their dependence either directly or indirectly from claim 20, the Applicant also submits that these claims are allowable because Sherman and Waskiewicz do not disclose the added limitations of these claims. With respect to claim 32, the Office Action does not address how Sherman and Waskiewicz disclose a data structure that “includes for each class a class node and a recipient node, each class node referencing a child class, and each recipient node referencing a recipient account.” With respect to claims 33, the Office Action does not address how the program “is further configured to associate data sets with corresponding class nodes and recipient nodes.” With respect to claim 34, the Office Action does not address how the program “is further configured to associate each data set associated with each class node to each corresponding classes referenced by the class node, and associate each data set associated with each recipient node to the each corresponding recipient account referenced by the recipient node.” Thus, the Office Action does not show how the prior art reference (or references when combined) teach or suggest this claim limitation. MPEP § 2143. For these additional reasons, the rejections of claims 32-34 must be withdrawn.

K. Independent Claim 35

The Applicant respectfully submits that independent claim 35 is not obvious over Sherman and Waskiewicz because 1) Sherman teaches away from claim 35; and 2)

Sherman does not teach "creating a data set for each recipient in the class, wherein only the data set corresponding to the one recipient includes the second file."

First, Sherman teaches away from claim 35. Sherman is directed to synchronization of data, as described above with respect to claim 1. Claim 35 claims "creating a data set for each recipient in the class, wherein only the data set corresponding to the one recipient includes the second file." Thus, the data sets claim in claim 35 cannot be synchronized data, because "only the data set corresponding to the one recipient includes the second file." Because Sherman teaches away from claim 35, the Applicant respectfully submits that the rejection is improper and requests that the rejection of claim 35, and all claims depending therefrom, be withdrawn.

Second, Sherman does not teach "creating a data set for each recipient in the class, wherein only the data set corresponding to the one recipient includes the second file." Indeed, the Office Action actually supports this conclusion. On page 11, lines 13-15, the Office Action states that Sherman does not teach associating a first file with a class of recipients, and associating a second file with one recipient in the class. Thus, Sherman cannot disclose "creating a data set for each recipient in the class, wherein only the data set corresponding to the one recipient includes the second file" as stated at the top of page 11 in the Office Action. On this inconsistency alone the rejection must be withdrawn.

Regardless, the combination of Waskiewicz and Sherman does not teach "associating a first file with a class of recipients," "associating a first file with a class of recipients," "associating a second file with one recipient in the class," and "creating a data set for each recipient in the class, wherein only the data set corresponding to the one recipient includes the second file." In particular, the cited passages to Sherman and Waskiewicz teach only an e-mail data hierarchy for particular recipients. Such a hierarchy, however, does not teach the claimed association of first and second files as claimed with a class of recipients. Finally, Sherman and Waskiewicz teach only distributing data via e-mail or by a synchronization operation. Data is sent to recipients independent of any class or association. Thus, Sherman and Waskiewicz do not teach creating a data set wherein only the data set corresponding to the one recipient includes the second file."

For these reasons, the Applicant respectfully submits that the rejection of claim 35, and all claims depending therefrom, be withdrawn.

L. Dependent Claim 37

Claim 37 was rejected on the grounds that Sherman shown an association of a first file in an e-mail folder hierarchy. Office Action, pg. 12. The Applicant respectfully disagrees with the rejection.

In addition to being allowable due to its dependence indirectly from claim 35, the Applicant also submits that claim 37 allowable because Sherman and Waskiewicz do not disclose the added limitations of claim 37. In particular, the e-mail folder hierarchy of Sherman does not teach the step of associating the first file to include "defining the recipient accounts to include all recipients in the class and all recipients in any subordinate classes related to the class in the hierarchy." The folder hierarchy of Sherman is merely an e-mail folder hierarchy for a single user; it does not relate to multiple recipient accounts. Furthermore, Sherman and Waskiewicz, either alone or in combination, do not teach the claimed association of the first file. Rather, Sherman and Waskiewicz only teach the management of one or more user's e-mail accounts. For this additional reason, the Applicant respectfully requests that the rejection of claim 37 be withdrawn.

M. Dependent Claims 44 and 45

Dependent claims 44 and 45 were rejected on the grounds that Sherman disclosed a method of e-mail files as discussed in claim 35. Office Action, pg. 12. In addition to being allowable due to their dependence either directly or indirectly from claim 35, the Applicant also submits that these claims are allowable because Sherman and Waskiewicz do not disclose the added limitations, and also that the rejection is improper because it fails to address these added limitations.

First, Sherman and Waskiewicz do not disclose "the step of copying the first file to recipient accounts respectively corresponding to the recipients in the first class" as claimed in claim 44, and do not disclose the further step of "copying the second file to the recipient account corresponding to the one recipient" as claimed in claim 45. Again,

Sherman and Waskiewicz only teach the management of one or more user's e-mail accounts. This is not the same as the novel data distribution method as claims in claim 35 and further claims in claims 44 and 45. Neither Sherman nor Waskiewicz relate to multiple recipient accounts and the hierarchical association of data to the multiple recipient accounts. Accordingly, the Applicant respectfully submits that the rejection be withdrawn.

Second, the Office Action does not address the added limitations of claims 44 and 45, instead only referring to the rejection of claim 35. Thus, the Office Action does not show how the prior art reference (or references when combined) teach or suggest these claim limitations. MPEP § 2143. Because the Office Action does not address these limitations, the rejection of these claims must be withdrawn.

N. Independent Claim 46

Independent claim 46 was rejected for the same reasons that claim 35 was rejected. Because claim 46 recites similar limitations to claim 35, the Applicant incorporates the arguments presented with respect to claim 35 for claim 46. For the same reasons give with respect to claim 35, the Applicant respectfully submits that the rejection of claim 46, and all claims depending therefrom, be withdrawn.

O. Dependent Claim 48

Claim 48 was rejected for the same reasons that claim 37 was rejected. Office Action, pg. 13. In addition to being allowable due to its dependence indirectly from claim 46, the Applicant also submits that claim 48 allowable because Sherman and Waskiewicz do not disclose the added limitations recited in claim 48. In particular, the e-mail folder hierarchy of Sherman does not teach program code for associating the first file "defines recipients of the first file to include all recipients in the class and all recipients in any subordinate classes in the hierarchy related to the class." The folder hierarchy of Sherman is merely an e-mail folder hierarchy for a single user; it does not relate to multiple recipient accounts. Furthermore, Sherman and Waskiewicz, either alone or in combination, do not teach the claimed association of the first file. Rather, Sherman and Waskiewicz only teach the management of one or more user's e-mail

accounts. For this additional reason, the Applicant respectfully requests that the rejection of claim 48 be withdrawn.

P. Dependent Claims 24, 25 and 27-31


Dependent claims 24, 25 and 27-31 were rejected over Sherman and Waskiewicz further in view of Reed. With respect to claims 24 and 25, which depend from claim 22, the Office Action does not address the limitation "distribution control file" as claimed in claim 22. Thus, the Office Action does not show how the prior art reference (or references when combined) teach or suggest this claim limitation. MPEP § 2143. Accordingly, the rejection of claims 24 and 25 must be withdrawn, as Sherman and Waskiewicz further in view of Reed have not been shown to teach this limitation.

With respect to claims 27-31, which depend from claim 26, the Office Action states that the graphics file of Sherman is a transaction file that stores a transaction history of the distribution of data sets. See Section I above. However, as stated above, a graphics file stores only graphical data; it does not that store a transaction history of the distribution of data sets. This limitation is also not addressed by Reed. Thus, the Office Action does not show how the prior art reference (or references when combined) teach or suggest this claim limitation. MPEP § 2143. Thus, the rejection of claims 27-31, which depend from claim 26, must be withdrawn.

III. Conclusion

For the reasons stated above, the Applicant respectfully submits that the pending claims are allowable over the art of record and requests that a Notice of Allowance be issued in due course.

Respectfully submitted,



Paul E. Franz, Reg. No. 45,910